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REMARKS

A Notice of Appeal to the Board of Patent Appeals and Interferences in this application was filed on March 1, 2002. The appeal has been docketed by the Board as Appeal No. 2003-1616. While all briefs and answers have been filed no decision has yet been rendered. Claims on appeal are Claims 1-164. Issues on appeal involve both prior art and the claim structure.

Prosecution is closed on the present application in accordance with 37 C. F. R. §§ 1.113 and 1.114.

Applicants have concurrently been prosecuting a counterpart application in the European Patent Office. During the prosecution of the EPO case, and subsequent to the filing of the Notice of Appeal in the present case, prior art was cited by the EPO. Included among the art cited by the EPO were five references which had not previously been known to Applicants. In addition, a supplemental search was conducted which also identified prior art which had not previously been known to Applicants. It is believed that these items of newly-identified prior art may be material to patentability of the subject matter of the claims on appeal in this case, such that this art should be brought to the attention of the USPTO for inclusion in the examination of this application.

All newly identified prior art is presented herewith in a supplemental Information Disclosure Statement. The prior art cited in the EPO patent application is believed to be the most relevant, and may be comparable in relevance to the Benny et al. reference (U.S. Patent No. 4,394,259; previously of record). The new art cited by the EPO consists of Japanese Abstracts to Yahata Denki Seikou KK (Publ. No. 57 001124), Toho Kikai Kogyo KK (Publ. No. 59 209991) and Kyoei Zoki KK (Publ. No. 56 161224), a German patent to Lucas (DE OS 25 10 415) and a French Patent to Maitre et al. (FR 2 752 048). The Japanese abstracts are in English. Partial English translations are provided for the French (the Abstract) and German (Claim 1) references.

It is submitted that return of the application to the Examiner for further examination is appropriate, since any decision on appeal currently would address only the Benny et al.

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reference, and not the new references. Therefore any decision on appeal might not fully resolve patentability of the claimed subject matter in view of the new art.

In order to avoid the prior art and to reduce the number of issues in this case, Applicants by the current amendment are cancelling Claims 1-164 and are submitting new Claims 165-204. These new claims are narrowed in scope from the scope of Claims 1-164, in that all claims to a vacuum ice conveyance system comprising only a single unbranched conduit between two terminals have been removed. This reduction in scope clearly avoids not only the Benny et al. reference but also the newly identified references, including but not limited to the above-mentioned Japanese, French and German references. The prior art rejection currently on appeal is therefore submitted to be avoided, eliminating that issue. The avoidance of the newly identified prior art also removes those references as a potential issue in the Continued Examination.

Applicants' amendment of the claims also reduces the number of claims from 164 (plus multiple dependencies) to 40 (with no multiple dependencies), a 75%+ reduction in the number of claims. An issue during the prior examination and also on appeal has been a "multiplicity-prolix" rejection under 35 U.S.C. §112, paragraph 4, 37 C.F.R. 1.75(b), M.P.E.P. 2173.05(n) and M.P.E.P. 2173.05(m) set forth by the Examiner. It is submitted that the present amendment avoids this rejection. It is submitted by Applicants that the new total of only 40 claims, each itself being concise and clear, is fully commensurate with the nature of the complex vacuum ice conveyance system of this invention, thus avoiding any issue of multiplicity or prolixity; M.P.E.P. §§ 706.03(k), 2173.05(m) and 2173.05(n).

New claims 165-204 follow the prior characterizations of the invention but avoid the prior art and significantly simplify the claim structure. Claims 165-192 recite an apparatus and claims 193-204 recite a method. Many of the detailed aspects of the prior claimed embodiments have been eliminated as the subject of individual claims (but are within the scope of the remaining more generic claims). The independent apparatus claim, Claim 165, is drawn along the lines of former claim 1, but is narrower (to avoid Benny et al. and the newly cited art) in that it further spells out that the system includes a plurality of

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receptors to which ice is conveyed at each of a plurality of remote locations under negative pressure through a hollow elongated ice conduit. Additionally, claim 165 recites an intermediate division point from which a plurality of branch conduits extend and a diverter in said conduit at each said intermediate division point for direction of ice traversing said conduit from said initial conduit to any of said branch conduits.

Similarly, narrowed independent method claim 193 is the successor to original independent method Claim 126. It recites disposing a plurality of receptors for receiving ice at remote locations, disposing a diverter in a conduit at an intermediate diversion point and controlling said diverter to direct ice transversely said conduit from said initial conduit to any one of said branch conduits. This concept is not disclosed by the art of record or the art included with the Information Disclosure Statement. Further diversion to one of the number of conduits is neither taught nor suggested by the art of record.

New independent claims 165 and 193 therefore now require that the vacuum system be branched so that ice can be conveyed from a source to any of a plurality of locations. Subsequent dependent claims provide more detail and include multiple branching and additional ice sources. Branched, substantially fully vacuum ice conveyance systems have not previously been known in the prior art, nor would they be obvious from simple single-conduit "vacuum cleaner" ice movers.

In view of the above, it is believed that filing of a Request for Continued Examination and concurrent withdrawal of the appeal is appropriate under 37 C.F.R. § 1.114 and M.P.E.P. § 1215.01 to enable the newly identified art to be submitted to the Examiner for consideration and the issue of claim structure to be reconsidered. The Request for Continued Examination is being filed herewith and this Amendment of the claims is simultaneously filed therewith.

It is also believed that return of the application to the Examiner may resolve all issues without involving return to appeal. Applicants believe that new Claims 165-204 avoid all prior art (both that previously or record and the newly identified art) and also avoid any issue of prolixity or multiplicity, and therefore are in condition for allowance, which

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allowance is respectfully requested.

FEES

Other than the fee required for filing of the Request for Continued Examination for which payment is submitted with said Request, it is not believed that any fees are due with respect to the amendment of the claims herein. However, should any such fees be due, the Patent and Trademark Office is authorized to charge all such fees to Deposit Account No. 02-4070.

CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection and objection, including those which have currently been on appeal, as well as all potential grounds based on the newly identified prior art, have been avoided and/or traversed. The Examiner is therefore respectfully requested to enter the amendments herein, reconsider and withdraw the prior rejections and objections and allow Claims 165-204, as amended, all claims in the case following amendment.

Should the Examiner believe that prosecution of this application might be expedited by further discussion of the issues, a telephone call to the undersigned attorney, collect, at the telephone number listed below, is cordially invited.

Respectfully submitted,

Date: August 28, 2003

By: _____


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